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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/813,430 | 03/31/2004 | Patrick O'Mahony | 66396-153 | 3797 |

7590 06/13/2005
MCDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

COHEN, AMY R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2859

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/813,430 | Applicant(s) O'MAHONY ET AL. | |
| | Examiner Amy R. Cohen | Art Unit 2859 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 21-25 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 21-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/31/04, 3/24/05</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-13, 21-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,839,972. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-13, 21-25 are directed to a position determination system and method comprising first and second rotation means for rotating the first and second sensing devices without altering the positional relationship between the first sensing device and the calibration sensing device and the second sensing device and the calibration target. Claims 1-33 of Patent 6,839,972 claim a broader position determination system and method comprising first and second means for repositioning the sensing fields of the first and second sensing devices without altering the positional relationship between the first sensing device and the calibration target and the second sensing device and the calibration sensing device.

It is noted that the first measuring module of the current application comprises the calibration sensing device and the second measuring module comprises the calibration target.

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The relationship of “first” and “second” is not a patentably distinct relationship from the U. S. Patent No. 6,839,972 since either measuring module or measuring apparatus could be labeled “first” or “second.”

Claim Objections

3. Claims 21 are objected to because of the following informalities:

Claim 21, line 6 “th e” should read --the--.

Claim 22 claim language is unclear since claim 22 claims “at least one position sensor...” and is dependent upon claim 1 which already claims a first sensing device for obtaining positional data in the first measuring module and a second sensing device for obtaining positional data in the second measuring module, and a data processing system coupled to the first and second measuring modules. In addition, there is not relationship between the first and second sensing devices (which sense position and can be considered “position sensors”) and the first and second measuring modules. For purposes of prosecution, the subject matter of claim 22 is considered to be inherent in the subject matter of claim 1.

Claim 24 claim language is unclear since claim 24 claims “at least one position sensor...” and is dependent upon claim 1 which already claims a first sensing device for obtaining positional data in the first measuring module and a second sensing device for obtaining positional data in the second measuring module, and a data processing system coupled to the first and second measuring modules. In addition, there is not relationship between the first and second sensing devices (which sense position and can be considered “position sensors”) and the

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first and second measuring modules. For purposes of prosecution, the subject matter of claim 24 is considered to be inherent in the subject matter of claim 21.

Appropriate correction is required.

Conclusion

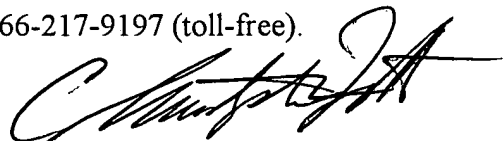
4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patent discloses a self-calibrating machine Jackson et al. (U. S. Patent No. 6,731,382).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R. Cohen whose telephone number is (571) 272-2238. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ARC
June 9, 2005



Christopher Fulton
Primary Examiner
Tech Center 2800